

REMARKS**Rejection under 35 U.S.C. § 102 over the Rink Reference**

Claims 1-22 have been rejected as anticipated by the Rink et al. reference, U.S. Patent 5,759,631. Applicants respectfully traverse the rejection and request reconsideration.

The present invention requires that the acrylic polymer of (a) is from about 5% up to about 60% by weight of the combined weight of the acrylic polymer of (a) and the film-forming polymer or polymers of (b). As the Office Action points out on page 3, the Rink patent resins different from acrylate resin (A) are 0-25% by weight of the solid binder. In the present invention, given that acrylic polymer (a) is 5-60% by weight of combined polymers (a) and (b), the polymer(s) of (b) must be 40-95% of the combination. The Rink patent does not disclose this limitation.

Because the Rink patent does not disclose each and every limitation of the claims, Appellants respectfully submit that the present claims are patentable over the Rink patent. Withdrawal of the rejection and reconsideration of the claims are requested.

Rejection under 35 U.S.C. § 103(a) over Rockrath in View of Rink

Claims 1-16 and 22-25 have been rejected as unpatentable over the Rockrath et al. patent, U.S. Patent 5,716,678 in view of the Rink patent. Applicants respectfully traverse the rejection and request reconsideration.

Applicants' evidence of unexpected results for the refinish clearcoat composition of the invention containing an acrylic polymer having a number average molecular

weight of at least about 5000 and polymerized using at least about 45% by weight of a cycloaliphatic monomer demonstrates the unexpected benefit of this composition over the more general compositions suggested by the Rockrath patent.

Secondly, the Rockrath patent does not disclose a *refinish* coating composition. The Rockrath coating compositions are formulated to cure at high bake, OEM cure conditions. As evidenced by the excerpt from the "Coatings" article from the Encyclopedia of Polymer Science and Engineering and the discussion in paragraphs 3 and 4 of the present application, automotive refinish coating compositions are recognized as a distinct coatings technology. One key attribute and requirement of a refinish coating is the ability to cure at room temperature or a very low temperature of room temperature or up to about 150°F (65°C.). This important attribute is lacking in the Rockrath compositions, which must be cured at high bake temperatures. The Rockrath patent nowhere describes or suggests a refinish coating composition. Because it does not describe a refinish coating composition, however, it cannot anticipate the present claims.

The Examiner contends, on page 10 of the Office Action, that the temperature at which the topcoat and the basecoat are baked together is not the curing temperature of the acrylic resin. The Examiner's statement makes no sense and is unsupported. The acrylic resin doesn't have a separate "curing temperature." That doesn't make any sense. The bake temperature is the curing temperature of the coating, and the Rockrath bake temperature and coating are OEM bake temperature and coating, not refinish bake temperature or refinish coating.

It is an essential property of a refinish coating that it be curable under refinish conditions. The Rockrath composition requires the higher bake temperature of OEM coatings. It is not, therefore, a refinish coating.

Nor is the Rockrath patent concerned with the problems of refinish coatings, such as the problem of dry time or tack-free time that is solved by the present invention.

In addition, the Rockrath patent does not teach or disclose refinish compositions including at least one film-forming polymer in addition to its polyacrylate resin. Moreover, the Rockrath patent does not teach or disclose that its polyacrylate resin should be from about 5% up to 60% by weight of the combined weight of its polyacrylate resin and of a film-forming polymer other than its polyacrylate.

The Examiner has emphasized that the Declarations provide a **single data point**. The Declarations actually provide two data points. One point is a comparative example based on the Rink patent example E3. The present inventors modified the acrylic of example E3 to make it more like the acrylics of the present invention for a better comparison. The differences in refinish clearcoat properties, specifically the dust free and tack free times that are extremely important for refinish, were striking.

The Examiner asserts in the new rejection that "it is within the skill of those skilled in the art to add additional film forming polymer resin as taught by Rink . . . to enhance film forming properties and impart other desirable properties." The Examiner then lists a few properties that neither reference suggests are obtained by including additional resins. This clearly is not the motivation required for *prima facie* obviousness. The secondary reference merely holds out an invitation to experiment as to the composition of the outer layer; much more is required by 35 U.S.C. § 103.

Knowing that a modification lies within the universe of possibilities is not sufficient to make it obvious that such a modification is desirable.

Applicants thus submit that the claims are patentable over the combination of the Rockrath patent and the Rink patent. Reconsideration of the claims is respectfully requested.

Rejection under 35 U.S.C. § 103(a) over WO 97/22646 in View of Rink

Claims 1-3, 5-21, and 23-25 have been rejected as unpatentable over the WO'646 document in view of the Rink patent. Applicants respectfully traverse the rejection and request reconsideration of the claims.

The WO'646 document does not teach or disclose a refinish composition or method. The Office Action refers to page 10 and lines 1-10 of page 11. This passage teaches a cure temperature of 160 to 350°F, well above feasible refinish curing temperatures.

Moreover, in the last paragraph on page 4, the WO'646 document teaches that its film forming composition is entirely made up of its acrylic solution polymer (60-90%) and its polyisocyanate crosslinking agent (10-40%). This passage leads one away from including any further film-forming polymer, such as the film-forming polymer (b) of the present claims. This description of the WO'646 document's film-forming composition on page 4 means that the reference is not "silent," as the Office Action characterizes it, but opposing.

Even were this not so, the vague rationale the Office Action offers for turning to the Rink patent does not constitute legal motivation, as Applicants discussed with regard to the rejection of Rink in combination with the Rockrath patent.

For all of these reasons, Applicants respectfully request withdrawal of the rejection and reconsideration and allowance of the claims.

Conclusion

Applicants believe that the claims are in condition for allowance, and an early allowance of the application is earnestly requested.

The Examiner is invited to telephone if it would be helpful to resolving any matter.

Respectfully submitted,


Anna M. Budde
Registration No. 35,085

June 29, 2004
Harness, Dickey & Pierce, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600